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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,598	02/22/2002	Otis Franklin Bell	2871	5730

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EXAMINER
FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
1762	9

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/082,598	BELL, OTIS FRANKLIN	
	Examiner	Art Unit	
	William P. Fletcher III	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) *21,22,25 and 26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20,23,24,27 and 28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *See Continuation Sheet* .

Continuation of Attachment(s) 6). Other: definitions of "solely" and "acrylic".

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see paper no. 8, filed 30 May 2003, with respect to the objections to the title and abstract in paper no. 7 have been fully considered and are persuasive. The objections have been withdrawn.

2. Applicant's arguments, see paper no. 8, filed 30 May 2003, with respect to the rejections of claims 9, 10, 12, 20, and 24 have been fully considered and are persuasive. The rejections of these claims have been withdrawn.

3. Applicant's arguments, see paper no. 8, filed 30 May 2003, with respect to the rejection(s)of claim(s) 1 – 4, 6, 7, 9 – 14, 16, 17, 19, and 20 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is/are set-forth below.

4. Applicant's arguments, see paper no. 8, filed 30 May 2003, with respect to the rejection(s)of claim(s) 5, 8, 15, 18, 23, and 24 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is/are set-forth below.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claims 27 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter**

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. These new claims recite that the masking composition is removed "solely with water." Since applicant has not specifically defined "solely," the examiner has interpreted this term according to its ordinary meaning: "without another; to the exclusion of all else."[1] The originally-filed disclosure, at p. 13 of the spec., discloses that the masking composition may be removed by ordinary or pressure washing with "water." The limitation "solely with water" reads on washing with absolutely nothing other than pure H_2O — this excludes tap water and even distilled and de-ionized water because such can contain things other than H_2O (if only dissolved O_2 or N_2 from the air). This degree of specificity is not supported by the originally-filed disclosure.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 19, 27, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

10. With respect to claim 19, this claim recites "said polymer." There is insufficient antecedent basis for this limitation in the claim. The examiner suggests claim language such as "said copolymer," "said film-forming copolymer," or "said film-forming, carboxylic acid-containing copolymer," for clarity.

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[1] *Merriam-Webster's Collegiate Dictionary, 10th Edition*, © 1998 by Merriam-Webster, Inc., p. 1118, attached.

11. With respect to claims 27 and 28, these claims recite removing the masking coating "solely with water." As noted above, this limitation excludes anything in addition to pure water, including pressure. The specification, at p. 13, discloses that the masking coating may be removed by pressure washing. Applicant, consequently, appears to utilize the term "solely" in a fashion contrary to it ordinary meaning. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. **Claims 1, 2, 11, 12, 23, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by VanWinckel (US 5,618,582 A).**

14. VanWinckel teaches a method for temporarily protecting a portion of a surface that is to be coated with a coating compound [abstract]. The method comprises: applying, to a portion of the surface, a continuous coating of a masking material; coating said surface with a coating compound, the masking material protecting the portion of the surface from the coating compound; and, thereafter, removing the masking material from the surface [abstract].

15. VanWinckel teaches that the masking material may be an aqueous acrylic emulsion [c. 3, l. 40 – c. 4, l. 43]. The term "acrylic" is inclusive of polymers or copolymers of (meth)acrylic acid as well as esters of these acids.[2] It is, therefore, the examiner's position that VanWinckel's teaching of an "acrylic" emulsion is inclusive of a carboxylic acid-containing polymer and, with respect to claims 23 and 24, copolymers of (meth)acrylic acid and (meth)acrylic acid esters.

16. If applicant contends that the additional components of VanWinckel are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the addition of each of these components would materially change the characteristics of applicant's invention [see *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964)].

Claim Rejections - 35 USC § 103

17. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

18. **Claims 1 – 3, 6, 7, 9 – 13, 16, 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanWinckel (US 5,618,582 A) in view of Roberts (US 5,453,459 A).**

19. VanWinckel teaches a method for temporarily protecting a portion of a surface that is to be coated with a coating compound [abstract]. The method comprises: applying, to a portion of the surface, a continuous coating of a masking material; coating said surface with a coating compound, the masking material protecting the portion of the surface from the coating compound; and, thereafter, removing the masking material from the surface [abstract].

20. While VanWinckel teaches that the masking material may be an acrylic emulsion [c. 3, l. 40 – c. 4, l. 42], the reference does not teach the specific composition claimed by applicant.

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[2] *Hawley's Condensed Chemical Dictionary, 12th Ed.*, © 1993 by Van Nostrand Reinhold, p. 19, attached.

21. Roberts teaches a masking material composition for temporarily protecting a surface from a coating. The masking material composition comprises an aqueous dispersion of a film-forming acrylic polymer or copolymer and an acetylenically unsaturated nonionic surfactant, with all other components being optional [abstract; c. 2, ll.21 – 28; c. 2, l. 60 – c. 3, l. 31; c. 4, l. 15 – c. 5, l. 31; c. 13, ll. 39 – 56; and the claims]. The acrylic polymer can be a polymer or copolymer of acrylic acid, or an acrylate; preferably a partially neutralized acrylic acid copolymer [c. 2, l. 60 – c. 3, l. 1]. Roberts requires only the surfactant in addition to the acrylic acid film-forming polymer or copolymer, examples of which in clued SURFYNOL surfactants [c. 3, ll. 42 – 48]. Since applicant discloses, at p. 9 of the spec., that their coating composition may also contain a surfactant, including SURFYNOL surfactants, it is the examiner's position that the addition of such a surfactant does not materially affect the basic and novel characteristics of the claimed invention [see *In re Herz*, 537 F.2d 549, 551 – 52, 190 USPQ 461, 463 (CCPA 1976) which presents a similar factual situation]. Consequently, Roberts' composition reads on an aqueous solution or emulsion *consisting essentially of* a film-forming, carboxylic acid-containing polymer [see MPEP § 2111.03]. If applicant contends that the addition of surfactant is excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the addition of surfactant would materially change the characteristics of applicant's invention [see *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964)].

22. Since VanWinckel teaches that the masking material composition may be an acrylic emulsion, but places no further limitation thereon, one of ordinary skill in the art would have looked to the prior art to find a suitable acrylic emulsion composition for masking a surface to protect it from unwanted application of a coating composition. Consequently, it would have

been obvious to one of ordinary skill in the art to modify the method of VanWinckel so as to apply, as the acrylic emulsion masking composition, the composition of Roberts. One of ordinary skill in the art would have been motivated to do so at least by the expectation of similar results: successfully masking the surface from the unwanted application of a coating composition. The examiner further notes that both VanWinckel and Roberts teach masking glass surfaces [VanWinckel, c. 3, ll. 5 – 15, for example; Roberts, c. 5, ll. 42 – 48 and c. 13, ll. 39 – 56].

23. With specific respect to claims 6, 7, 16, and 17, Roberts teaches the addition of sufficient alkali to neutralize the polymer [c. 3, ll. 25 – 31]. The pH of the resulting composition is in the range of 7 to about 10.5, which includes applicant's claimed pH of "about 7.1" [c. 4, l. 15 – c. 5, l. 31].

24. With respect to claims 9, 10, 19, and 20, Roberts teaches from about 3 to about 25 wt.-% polymer, the lower endpoint of which falls within applicant's claimed range of "from about 2 to about 10" (claims 9 and 10), and which includes applicant's claimed "about 5" (claims 10 and 20) [c. 4, table at bottom].

25. With respect to claims 27 and 28, it is the examiner's position that pressurized water washing is a well-known expedient to removing protective coatings from surfaces and it would, therefore, have been obvious to one of ordinary skill in the art to utilize such a method to remove the coating of VanWinckel in view of Roberts. As noted above, pressurized water washing appears to be encompassed by applicant's definition of "solely with water."

26. **Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanWinckel (US 5,618,582 A) in view of Roberts (US 5,453,459 A), as applied to claims 1 and 11 above, respectively, in further view of Zajac (WO 98/55535).**

27. The teaching of VanWinckel in view of Roberts is detailed above. Roberts does not explicitly teach that the masking composition comprises EDTA, although Roberts does teach the addition of conventional adjuvants [c. 4, ll. 44 – 53].

28. Zajac teaches a similar (meth)acrylic acid copolymer-based protective coating composition to which EDTA is added as a chelating agent [abstract]. The EDTA improves the shelf-life of the protective coating composition by reducing the amount of sediment created during storage [p. 10, ll. 11 – 21].

29. Consequently, it would have been obvious to one of ordinary skill in the art to modify the method of VanWinckel in view of Roberts so as to include, in the protective coating composition, EDTA. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of improving the shelf-life of the coating composition, as described by Zajac.

30. **Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanWinckel (US 5,618,582 A) in view of Roberts (US 5,453,459 A), as applied to claims 1 and 11 above, respectively, in further view of Maxwell et al. (US 6,011,107 A).**

31. Maxwell teaches a similar (meth)acrylic acid copolymer based protective coating composition [abstract]. Maxwell teaches: "...the proportions of the various resins may be varied...so as to adjust the overall performance of the film" [c. 6, ll. 14 - 15]. Maxwell further

teaches: "...the viscosity can be adjusted by varying the relative amounts of the resin components" [c. 6, ll. 23 - 24].

32. The examiner further notes that it is also well-known to adjust the viscosity of a coating composition by the addition of thickeners.

33. Consequently, the viscosity of the (meth)acrylic acid copolymer based protective coating composition is a result-effective variable, effecting the overall performance of the film, that may be adjusted by varying relative amounts of resin components or adding thickeners.

34. Absent a clear and convincing showing of unexpected results demonstrating the criticality of the claimed viscosity range, it would have been obvious to one of ordinary skill in the art to optimize the viscosity of the protective coating composition by routine experimentation so as to achieve a desired overall performance of the coating composition [see MPEP § 2144.05(II)].

35. **Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanWinckel (US 5,618,582 A) in view of Roberts (US 5,453,459 A), as applied to claims 1 and 11 above, respectively, in further view of Zajac (WO 98/55535) or in further view of Kawabata (US 5,194,483 A).**

36. The teaching of VanWinckle in view of Roberts is detailed above. Roberts further teaches that "[a]crylic acid copolymers with other vinyl monomers...which provide polymeric film-forming materials can also be used in the practice of this invention" [c. 3, ll. 18 - 24]. Roberts does not explicitly teach a copolymer of methacrylic acid and ethylacrylate.

37. Both Zajac and Kawabata teach similar (meth)acrylic acid copolymer based protective coating composition. Specifically, they both teach copolymers of methacrylic acid and

ethylacrylate [Zajac, p. 6, l. 25 - p. 7, l. 30 and Kawabata, c. 3, ll. 17 - 29]. All of these references deal with removable, protective coating compositions for motor vehicle surfaces.

38. Since Roberts teaches a removable, protective coating composition in which copolymers of acrylic acid and vinyl monomers may be utilized as the only film-forming component, and Zajac and Kawabata each teach similar coating compositions utilizing copolymers of acrylic acid and ethylacrylate as film-formers, it would have been obvious to one of ordinary skill in the art to modify the method of Roberts so as to utilize, as the copolymer, a copolymer of methacrylic acid and ethylacrylate, as suggested by either Zajac or Kawabata. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully forming a removable, protective coating.

39. **Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanWinckel (US 5,618,582 A) in view of Roberts (US 5,453,459 A), as applied to claims 1 and 11 above, respectively, in further view of Ely et al. (US 5,550,182 A).**

40. The teaching of VanWinckel in view of Roberts is detailed above. VanWinckel focuses on the particular application of the masking composition to residential window glass bordered by a wooden frame [c. 6]. Although the coating may be used on glass bordered by metal [c. 9, ll. 25 – 67], as is typical in automotive applications, VanWinckel does not directly suggest that the metal surface is the surface of a motor vehicle. Roberts teaches that the masking composition may be applied to a motor vehicle substrate, including automotive window glass [c. 1, ll. 15 – 50; c. 5, ll. 42 – 48; and c. 13, l. 30 – c. 14, l. 30], but does not directly suggest that the coating masks only a portion of the surface.

41. Ely teaches that it is known in the art to protect glass portions of a motor vehicle substrate from unwanted paint application by the selective application of a removable masking composition [c. 1, ll. 10 – 17].

42. It would have been obvious to one of ordinary skill in the art to modify the method of VanWinckel in view of Roberts so as to apply the masking composition of Roberts to a motor vehicle substrate. It is the examiner's position that the teachings of these references, taken as a whole, would have suggested to one of ordinary skill in the art that, at the interface between an automotive vehicle surface and a window, the masking composition of Roberts, applied according to the method of VanWinckel, would serve to protect the glass from unwanted paint application, as suggested by Ely.

43. **Claims 6 – 10, 16 – 20, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanWinckel (US 5,618,582 A).**

44. It is the examiner's position that the pH, viscosity, and relative proportions of resin components are all result-effective variables determining the final properties of the masking composition. Absent clear and convincing showings of unexpected results demonstrating the criticality of the claimed ranges, it would have been obvious to one of ordinary skill in the art to optimize such result-effective variables by routine experimentation [MPEP § 2144.05(II)].

45. With respect to claims 27 and 28, it is the examiner's position that pressurized water washing is a well-known expedient to removing protective coatings from surfaces and it would, therefore, have been obvious to one of ordinary skill in the art to utilize such a method to remove the coating of VanWinckel in view of Roberts. As noted above, pressurized water washing appears to be encompassed by applicant's definition of "solely with water."

Conclusion

46. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

47. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (703) 308-7956. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

49. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

50. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

William P. Fletcher III
Examiner
Art Unit 1762

WPF
August 8, 2003

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